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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/475,391	12/30/1999	CARLOS A. SILVA JR.	06975/048001	6275
26171	7590	11/18/2004	EXAMINER	
FISH & RICHARDSON P.C. 1425 K STREET, N.W. 11TH FLOOR WASHINGTON, DC 20005-3500			BAUGH, APRIL L	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/475,391	<b>Applicant(s)</b> SILVA ET AL.	
	<b>Examiner</b> April L Baugh	<b>Art Unit</b> 2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 36-74 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Response to Amendment***

Claims 36-74 are now pending.

### ***Response to Arguments***

1. Applicant's arguments with respect to claim 36, 47, and 68 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 68 rejected under 35 U.S.C. 102(e) as being unpatentable by US patent No. 6,677,968 to Appleman.

Regarding claim 68, Appleman teaches a method of providing a buddy list to a network user, the method comprising: receiving user definition of a first buddy list, the first buddy list comprising members defined by the network user, the members comprising one or more other network users; receiving user definition of a second buddy list, the second buddy list comprising members defined by the network user, the members comprising one or more other network users;

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receiving user input; triggering, based on the received user input, selection of a buddy list among the first buddy list and the second buddy list; and displaying the selected buddy list to the network user on an instant messaging user interface, wherein the displayed buddy list comprises online presence information for the members of the selected buddy list (column 1, lines 63 through column 2, line 4 and column 3, lines 1-7 and 46-53 and column 4, lines 51-58 and column 6, lines 53-60).

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 36-43, 47-60, 62-66, 69-72 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,081,830 to Schindler in view of Porter (US Patent 6434599) and further in view of Appleman (US patent No. 6,677,968).

Regarding claim 36 and 47, Schindler teaches a method and a computer program disposed on a computer readable medium for providing a buddy list to a network user, the method comprising: determining television programming selected for viewing by a network user at a networked device (column 2, lines 6-16); selecting a chat room based upon the determined television programming (column 3, lines 54-56).

Schindler does not teach selecting a buddy list based on television programming. Porter teaches selecting an initial buddy list based upon the determined television programming (column 1, lines 26-27 and column 10, lines 25-28). Therefore it would have been obvious to one of ordinary skill in the art to further modify the automatic linking to program-specific computer chat rooms of Schindler by selecting a buddy list based on television programming because just as a user may choose to chat in a particular chat room where those present are discussing a particular program, the user may also want to instant message a user from a pre-defined buddy list of users who care to discuss that particular program as well.

Schindler in view of Porter does not teach of a pre-defined buddy list of network users, wherein the list displayed on an IM user interface comprises online presence information for the members of the list. Appleman teaches accessing two or more user-defined lists of other users for whom presence is monitored; selecting an initial buddy list from among the two or more user-defined list, each buddy list comprising one or more members defined by the network user, the members comprising one or more other network users; and displaying the selected initial buddy list to the network user on an instant messaging user interface, wherein the displayed buddy list comprises online presence information for the members of the selected initial buddy list (column 1, lines 63 through column 2, line 4 and column 3, lines 1-7 and 46-53 and column 4, lines 51-58 and column 6, lines 53-60). Therefore it would have been obvious to one of ordinary skill in the art to further modify the automatic linking to program-specific computer chat rooms of Schindler in view of Porter by accessing two or more user-defined lists of other users for whom presence is monitored; selecting an initial buddy list from among the two or more user-defined list, a pre-defined buddy list of network users, wherein the list displayed on an IM user interface comprises

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online presence information for the members of the list because the user knows which network user care to discuss particular programs so the list must be pre-defined and displaying the list based on the viewed program on the IM UI allows the user to instant message those that are currently online for immediate discussion of the TV program.

Referring to claims 43 and 52, Schindler teaches the method of claim 36 and 47 further comprising receiving information indicating a change in the television programming viewed by the network user (column 4, lines 59-65); selecting a different chat room based upon the changed television programming (column 2, lines 6-16).

Schindler does not teach selecting a different buddy list from among the two or more user-defined lists based upon the changed television programming. Porter teaches selecting a different buddy list from among the two or more user-defined lists based upon the changed television programming (column 1, lines 26-27 and column 10, lines 25-28). Therefore it would have been obvious to one of ordinary skill in the art to further modify the automatic linking to program-specific computer chat rooms of Schindler by selecting a different buddy list from among the two or more user-defined lists based upon the changed television programming because just as a user may choose to chat in a particular chat room where those present are discussing a particular program, the user may also want to instant message a user from a pre-defined buddy list of users who care to discuss that particular program as well. Therefore if there is a change in television programming then the buddy list of users who choose to discuss the new programming will change as well.

Schindler in view of Porter does not teach displaying the different buddy list to the network user on an instant messaging user interface. Appleman teaches displaying the selected

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different buddy list to the network user on an instant messaging user interface, wherein the displayed buddy list comprises online presence information for the members of the selected different buddy list (column 1, lines 63 through column 2, line 4 and column 3, lines 1-7 and 46-53 and column 4, lines 51-58 and column 6, lines 53-60). Therefore it would have been obvious to one of ordinary skill in the art to further modify the automatic linking to program-specific computer chat rooms of Schindler in view of Porter by displaying the different buddy list to the network user on an instant messaging user interface because displaying the new list on the IM UI allows the user to instant message those that are currently online for immediate discussion of the new program the user has switched to.

Regarding claim 56, 62, and 69, Schindler in view of Porter teaches the method of claim 36, 47, and 68 (column 1, lines 26-27 and column 10, lines 25-28 of Porter).

Schindler in view of Porter does not teach receiving user definition of a first buddy list and a second buddy list. Appleman teaches further comprising receiving user definition of a first buddy list and a second buddy list (column 1, lines 63 through column 2, line 4 and column 3, lines 1-7 and 46-53 and column 4, lines 51-58 and column 6, lines 53-60). Therefore it would have been obvious to one of ordinary skill in the art to further modify the automatic linking to program-specific computer chat rooms of Schindler in view of Porter by receiving user definition of a first buddy list and a second buddy list because displaying the new list on the IM UI allows the user to instant message those that are currently online for immediate private discussion of the new program the user has switched to.

Regarding claim 57 and 63, Schindler teaches the method of claim 56 and 62 (column 1, lines 26-27 and column 10, lines 25-28 of Porter).

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Schindler in view of Porter does not teach selecting an initial buddy list comprises selecting an initial buddy list from among the first buddy list and the second buddy list.

Appleman teaches wherein selecting an initial buddy list comprises selecting an initial buddy list from among the first buddy list and the second buddy list (column 1, lines 63 through column 2, line 4 and column 3, lines 1-7 and 46-53 and column 4, lines 51-58 and column 6, lines 53-60).

Therefore it would have been obvious to one of ordinary skill in the art to further modify the automatic linking to program-specific computer chat rooms of Schindler in view of Porter by selecting an initial buddy list comprises selecting an initial buddy list from among the first buddy list and the second buddy list because displaying the new list on the IM UI allows the user to instant message those that are currently online for immediate private discussion of the new program the user has switched to.

Referring to claim 58, 64, and 70, Schindler teaches the method of claim 57, 63, and 68 further comprising associating the buddy list with television programming (column 1, lines 26-27 and column 10, lines 25-28 of Porter).

Schindler in view of Porter does not teach associating the first buddy list and associating the second buddy list. Appleman teaches further comprising associating the first buddy list and associating the second buddy list (column 1, lines 63 through column 2, line 4 and column 3, lines 1-7 and 46-53 and column 4, lines 51-58 and column 6, lines 53-60). Therefore it would have been obvious to one of ordinary skill in the art to further modify the automatic linking to program-specific computer chat rooms of Schindler in view of Porter by associating the first buddy list and associating the second buddy list because displaying the new list on the IM UI



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allows the user to instant message those that are currently online for immediate private discussion of the new program the user has switched to.

Referring to claims 60 and 66, Schindler teaches the method of claim 59 and 65 wherein selecting an initial buddy list comprises selecting the first buddy list if the first television programming is selected for viewing by the network user (column 1, lines 26-27 and column 10, lines 25-28 of Porter).

Schindler in view of Porter does not teach selecting the first buddy list or selecting the second buddy list. Appleman teaches selecting an initial buddy list comprises selecting the first buddy list or selecting the second buddy list. (column 1, lines 63 through column 2, line 4 and column 3, lines 1-7 and 46-53 and column 4, lines 51-58 and column 6, lines 53-60). Therefore it would have been obvious to one of ordinary skill in the art to further modify the automatic linking to program-specific computer chat rooms of Schindler in view of Porter by selecting the first buddy list or selecting the second buddy list because displaying the new list on the IM UI allows the user to instant message those that are currently online for immediate private discussion of the new program the user has switched to.

Regarding claims 37 and 48, Schindler teaches the method of claim 36 and 47 wherein determining television programming comprises determining a television network (column 3, lines 46-56).

Referring to claims 38 and 49, Schindler teaches the method of claim 36 and 47 wherein determining television programming comprises determining a television show (column 4, lines 12-16).

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Regarding claims 39 and 50, Schindler teaches the method of claim 36 and 47 wherein determining television programming comprises determining a characteristic of a television show (column 1, lines 25-26).

Referring to claims 40 and 51, Schindler teaches the method of claim 39 and 50 wherein determining a characteristic comprises determining a type of the television show (column 1, lines 25-26).

Regarding claim 41, Schindler teaches the method of claim 40 wherein the type comprises sports (column 1, lines 23-29).

Referring to claim 42, Schindler teaches the method of claim 41 wherein determining television programming comprises determining a sports team (column 1, lines 23-29).

Regarding claims 59, 65, and 71, Schindler teaches the method of claim 58, 64, and 70 wherein determining television programming comprises determining whether the first television programming or the second television programming is selected for viewing by the network user (column 2, lines 6-16).

3. Claims 44-46 and 53-55, and 61, 67, and 73 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,081,830 to Schindler in view of Porter (US Patent 6434599) and further in view of Appleman (US Patent 6677968) as applied to claims 36-43 and 47-52 above, and further in view of DeSimone et al. (US Patent 6212548)

Regarding claims 44 and 53, Schindler in view of Porter and further in view of Appleman teaches multiple buddy lists (column 2, lines 6-16 of Schindler and column 1, lines 26-27 and column 10, lines 25-28 of Porter).

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Schindler in view of Porter and further in view of Appleman does not teach different buddy list. DeSimone et al. teaches the method of claim 43 and 52 wherein the different buddy list differs from the initial buddy list (column 2, lines 4-6 and 12-14 and column 14, lines 63-65). Therefore it would have been obvious to one of ordinary skill in the art at the time that the invention was made to further modify the automatic linking to program-specific computer chat rooms of Schindler in view of Porter and further in view of Appleman by having different buddy list because each buddy list will contain users that are interested in discussing different programs therefore as the user changes programs they will have a list of user willing to discuss that new program.

Regarding claims 45, 54, 61, 67, and 73 Schindler in view of Porter and further in view of Appleman teaches multiple buddy lists (column 2, lines 6-16 of Schindler and column 1, lines 26-27 and column 10, lines 25-28 of Porter).

Schindler in view of Porter and further in view of Appleman does not teach wherein at least one member of the different buddy list differs from the members of the initial buddy list. DeSimone et al. teaches the method of claim 43, 52, 56, 62, and 68 wherein at least one member of the different buddy list differs from the members of the initial buddy list (column 2, lines 4-6 and 12-14 and column 14, lines 63-65). Therefore it would have been obvious to one of ordinary skill in the art at the time that the invention was made to further modify the automatic linking to program-specific computer chat rooms of Schindler in view of Porter and further in view of Appleman by wherein at least one member of the different buddy list differs from the members of the initial buddy list because each buddy list will contain users that are interested in discussing

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different programs therefore as the user changes programs they will have a list of user willing to discuss that new program.

Regarding claims 46 and 55, Schindler in view of Porter and further in view of Appleman teaches multiple buddy lists (column 2, lines 6-16 of Schindler and column 1, lines 26-27 and column 10, lines 25-28 of Porter).

Schindler in view of Porter and further in view of Appleman does not teach wherein the members of the different buddy list differ from the members of the initial buddy list. DeSimone et al. teaches the method of claim 43 and 52 wherein the members of the different buddy list differ from the members of the initial buddy list (column 2, lines 4-6 and 12-14 and column 14, lines 63-65). Therefore it would have been obvious to one of ordinary skill in the art at the time that the invention was made to further modify the automatic linking to program-specific computer chat rooms of Schindler in view of Porter and further in view of Appleman by wherein the members of the different buddy list differ from the members of the initial buddy list because each buddy list will contain users that are interested in discussing different programs therefore as the user changes programs they will have a list of user willing to discuss that new program.

4. Claim 74 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,677,968 to Appleman in view of Schindler (US Patent 6081830).

Regarding claim 74, Appleman teaches the method of claim 68 (column 1, lines 63 through column 2, line 4 and column 3, lines 1-7 and 46-53 and column 4, lines 51-58 and column 6, lines 53-60).

Appleman does not teach determining television programming selected for viewing by a network user. Schindler teaches wherein receiving user input comprises determining television

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programming selected for viewing by a network user at a networked device (column 2, lines 6-16). Therefore it would have been obvious to one of ordinary skill in the art at the time that the invention was made to further modify the user-definable instant messaging buddy groups of Appleman by determining television programming selected for viewing by a network user because the system is better able to accommodate user preferences.

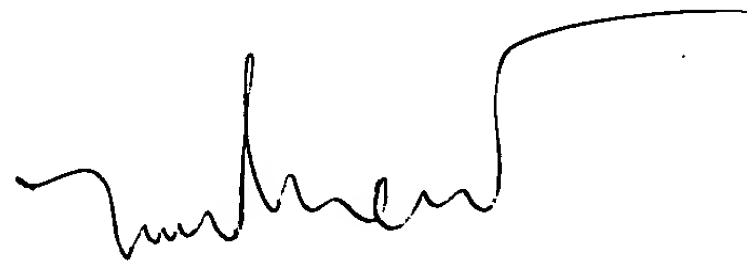
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April L Baugh whose telephone number is 571-272-3877. The examiner can normally be reached on Monday-Friday 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571-272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALB



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PRIMARY EXAMINER